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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,416	01/26/2005	Tadashi Ishida	018765-204	5645
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EXAMINER				
SHEWAREGED, BETTELHEIM				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
11/20/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

### Office Action Summary

**Application No.**

10/522,416

**Applicant(s)**

ISHIDA ET AL.

**Examiner**

Betelhem Shewareged

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's response along with the Request for Continued Examination (RCE) filed on 09/15/2008 has been fully considered. Claims 5 and 6 are amended, claims 3 and 4 are canceled, claim 7 is added, and claims 1, 2 and 5-7 are pending.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Galleguillos et al. (US 6,361,768 B1).

4. Galleguillos teaches an ampholytic copolymer having at least one anionic functional group and at least one cationic functional group (col. 4, line 36). The copolymer has a glass transition temperature of above 50 degree C, and is in a form of a fine powder with submicron particle size (abstract). Submicron particle size is a particle size of less than 1 um, which includes the claimed particle size. The copolymer can be used for paper coating (col. 19, line 2).

### ***Response to Arguments***

5. Applicant's argument is based on that the Galleguillos provides no explicit or implicit disclosure of employing an organic solvent or radiation curing in connection with

its paper coating, and the Examiner has not provided any explanation of how Galleguillos inherently discloses such subject matter. This argument is not persuasive for the following reason. The claimed invention is not limited to a water based coating solution to form the ink receptive layer. Even though the amphoteric particles of the prior art are hydrophilic, there is nothing that expressly teaches the particles will dissolve upon coating the paper. For the amphoteric particles to dissolve, as applicant indicated, these particles are required to be blended with a solvent that is capable of dissolving these particles, and there is nothing that teaches in the prior art, the particles are blended with solvent and are dissolved before or upon application of paper. If the art expressly teaches the particles are dissolved upon application of paper, Applicant is kindly asked to direct the Examiner to such teaching in the prior art.

6. Applicant has directed the Examiner's attention to col. 3, lines 56-58. However, there is nothing that teaches or suggests the coating in col. 3, lines 56-58 is used as a "paper coating". The copolymer powder of the prior art can be used for several purposes (col. 3, lines 58 and 59; col. 18, line 57 thru col. 19, line 25), and there is nothing that teaches the copolymer powder must be dissolved for **all** purposes. Specifically, the prior art does not teach or fairly suggest the copolymer powder must be dissolved for paper coating.

7. Applicant has directed the Examiner's attention to col. 4, lines 59-63 and col. 8, lines 41-52. However, there is nothing that teaches or fairly suggests that the particles in col. 4 and col. 8 are actually dissolved and coated on a paper. For example, the composition to be used as a shampoo may be different from the composition to be used

as a paper coating. The prior art does not teach or suggest the composition in col. 3, col. 4 and col. 8 are used as "paper coating".

8. The Declaration under 37 CFR 1.132 has been considered; however, does not provide any evidence as to the copolymer particles of the prior art are mixed with any type of solvents before being used as paper coating.

9. For the above reasons claims 1, 2, 5 and 6 stand rejected, and claim 7 is included in the rejection.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is (571)272-1529. The examiner can normally be reached on Monday-Friday 9am-5pm.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS  
November 15, 2008.

/Betelhem Shewareged/  
Primary Examiner, Art Unit 1794